

22. (currently amended) ~~A solid biomaterial according to claim 1, wherein said solid biomaterial consists in a coating for orthopedic, dental or maxillofacial prostheses.~~

Deleted: The process as claimed in

Deleted: including using the

Deleted: for the preparation of

23. (previously amended) A prosthesis, characterized in that at least part of its surface is coated with a solid biomaterial as claimed in claim 1.

### Remarks

Reconsideration and further examination of the above-identified patent application in light of the present Amendment, Reply, and Remarks is respectfully requested.

A Petition for an extension of time is enclosed along with the required extension fee.

Authorization is hereby given to charge any deficiency in fees or any other fees in connection with the above-identified patent application to our Deposit Account No. 23-0920.

The Specification has been amended to include a Cross Reference to Related Applications in compliance with the U.S. Patent Office Rules.

Claims 1- 23 were pending prior to this Amendment.

Claims 1-6, 8-11, and 13-23 were previously amended.

Claims 1, 3, 13, and 18-22 are currently amended.

Claims 1-23 are presently pending for the consideration of the Examiner.

The matters objected to in claims 3 have been corrected as per the Examiner's requests in order to make the claim more definite and clear and better comply with 35 USC 112. In particular, the term "Factors" has now been correctly spelled at lines 3 and 4. The undersigned attorney thanks the Examiner for pointing out these errors so that they can be corrected. The typographical and spelling errors were made through inadvertence and mistake without intent to deceive.

It is respectfully submitted that the nonstatutory double patenting rejection is no longer appropriate and is moot in view of the amended claims. In applicants' view, there is no overlapping between the scope of U.S. Patent No. 6,646,120 (the '120 patent)



and the present amended pending claims. The invention claimed in the '120 patent relates to dextran derivatives of the general formula  $DMC_aB_bSu_cS_d$  (see claims 1-5) and to a medicinal product comprising such derivatives as active principle (claim 6) optionally in combination with at least one additional active principal selected from the group consisting of an acidic fibroblast grow factor (FGF) (see claim 11). Significantly, according to the '120 patent, such dextran derivatives are soluble compounds. In contrast, the present invention recited in the amended claims, relates to a solid biomaterial incorporating an insolubilized dextran derivative. According to the specification of the present application (page 9, lines 1-9), the dextran is insolubilized by crosslinking with the aid of a crosslinking agent. This feature is neither taught nor suggested by the '120 patent. Therefore, there is no overlapping between claims 1-6 and 11 of the '120 patent and present amended claims 1-3 and 5 and other claims of the subject application. Accordingly, it is respectfully submitted that the double patenting rejection now be withdrawn.

A prior patent is a reference only for what it clearly discloses or suggests; it is improper use of a patent as a reference to modify it to that which it does not suggest; *In re Hummer*, 113 USPQ 66 (CCPA 1957). See also *In re Stencel*, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987).

Applicants' claims 20-22 have been currently amended to overcome the rejections under 35 USC §101 and §112. In particular, applicants' claims 20-22 have now been amended as product claims, rather than use claims, and now specify further features and limitations of the solid biomaterial of applicants' claim 1.

The matters objected to in applicants' claims 1, 13, 18, and 20-22 have been corrected or cancelled as per the Examiner's requests in order to make the claims more definite and clear and better comply with 35 USC §112.

In applicants' claims 1, the limitations in parentheses "(sulfation of the aromatic rings of the B groups)" which is a simple explanation and not a limitation, have been removed as per the Examiner's request. Also, the word "essentially" has been deleted in the term "essentially comprises" in applicants' claims 1 as per the Examiner's request.

Claims 13 and 18 have been amended to clarify the terminology "copolymers of polyethylene glycol with polylactide-co-glycolide" as per the Examiner's requests.

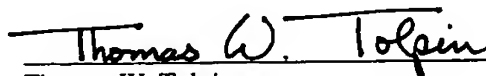


In summary, applicants' solid biomaterial and process therefore, as recited in the amended claims, provides a very useful and user friendly product and process, which is not anticipated or obvious from the '120 patent and the other references.

Inasmuch as the preceding amendment complies with the Examiner's requests and cures the Examiner's objections, it is respectfully submitted that the above-identified application is now in condition for allowance. A Notice of Allowance is respectfully requested.

The Examiner is invited and encouraged to contact the undersigned attorney in order to expedite this application to allowance, if the preceding does not already place the above-identified application in condition for allowance.

Respectfully submitted,

A handwritten signature in cursive script that reads "Thomas W. Tolpin". The signature is written in dark ink and is positioned above a horizontal line.

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